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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,593	10/23/2001	Edmund Campion	243768083US1	8557
30024	7590	09/12/2005	EXAMINER	
NIXON & VANDERHYE P.C. 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			GONZALEZ, JULIO C	
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/045,593

Applicant(s)

CAMPION, EDMUND

Examiner

Julio C. Gonzalez

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-28 is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-17 is/are rejected.
- 7) ☒ Claim(s) 11-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 5, 6, 8, 10, 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-26 of U.S. Patent No. 6,644,247. Although the conflicting claims are not identical, they are not patentably distinct from each other because both, the Patent Application and the Patent disclose a portable power module having a container, a gaseous fuel motor, an electrical generator, a radiator, an exhaust silencer, frequency switching and the same dimensions of the container.

3. Claims 1, 5, 6, 8, 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 10/001,908 (US 2003/0033994). Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications disclose a portable power module having a container, a gaseous fuel motor, an electrical generator, a radiator, an exhaust silencer, frequency switching and the same dimensions of the container.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1, 5, 6, 14, 15, 16, 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 10/045,617 (US 2003/0029390). Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications disclose a portable power module having a container, a gaseous fuel motor, an electrical generator, a radiator, an exhaust silencer, frequency switching and the same dimensions of the container.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 7, 8, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard et al (US 6,450,133) in view of Nettel (US 2,362,714), Staschik (US 6,393,775) and Uram (US 4,032,793).

Bernard et al discloses a portable power module having a fuel motor 38, generator 44, ambient air inlets 58, 80, a container 12 having all the portable power module inside (see figures 1, 2, 3).

Moreover, Bernard et al teaches using a silencer 45 linked with the device (column 4, lines 39-43).

However, the Bernard does not disclose explicitly having the fuel motor with a combustion chamber.

On the other hand, Nettel discloses for the purpose of providing a simple way of starting combustion turbines, a generator 6 being connected to fuel motor 3 and the motor 3 having a combustion chamber 8, fuel tank 9 and cooling means 17 (see figure 1).

However, neither Bernard et al nor Nettel disclose explicitly using a coolant liquid to be circulated in the system.

On the other hand, Staschik discloses for the purpose of providing power systems with efficient utilities services, a generator 249 connected to a motor 250 and the motor 250 having a coolant device 263 adjacent the motor 250 and a radiator 262 in flow communication with the coolant device 263 (see figure 10). Although it is well known in the art to have power module that produce at least one megawatt, neither Bernard et al, nor Nettel nor Staschik disclose that the generator produces at least one megawatt, which is driven by a motor.

On the other hand, Uram discloses for the purpose of providing a reliable and efficient turbogenerator synchronization that it is known in the art to have a motor driving a generator of power a plant and providing at least one megawatt (column 6, lines 31-40).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a portable power module as disclosed by Bernard et al and to disclose explicitly having a combustion chamber of the motor for the purpose of providing a simple way of starting combustion turbines as disclosed by Nettel and to provide a coolant liquid for the motor for the purpose of providing power systems with efficient utilities services as disclosed by Staschik and to

disclosed explicitly driving a generator for producing more than one megawatt for the purpose of providing a reliable and efficient turbogenerator synchronization as disclosed by Uram.

7. Claims 2, 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard et al, Nettel, Staschik and Uram as applied to claim 1 above, and further in view of ordinary skill in the art.

The combined power module discloses the claimed invention except for dimension of the trailer.

It would have been an obvious matter of design choice to use such trailer with the dimensions disclosed, since the applicant has not disclosed that the dimensions solve any stated problem or is for any particular purpose and it appears that the invention would perform equally well with trailer disclosed by the Prior Art.

8. Claims 9, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard et al, Nettel, Staschik and Uram as applied to claim 1 above, and further in view of ordinary skill in the art.

The combined power module discloses the claimed invention except for values disclosed in the above claims.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to disclose the optimum values disclosed in claims 9, 16, 17, since it has been held that discovering the optimum value of result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

#### ***Allowable Subject Matter***

9. Claims 18-28 are allowed.

10. Claims 5, 6, 10 – 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. It is further necessary for claims 5, 6 and 10 to overcome the Double Patenting rejection set forth above.

#### ***Response to Arguments***

11. Applicant's arguments filed 08/17/05 have been fully considered but they are not persuasive.



- With respect to the Double Patenting Rejection under Campion (US 6,644,247), it is disclosed in claim 14 (and other claims, too) using a gaseous fuel motor *positioned within the interior*, electrical generator being also positioned within the interior, radiator positioned within the interior, the exhaust gas silencer positioned within the interior and also it is further disclosed (see lines 1-3 of claim 14) that the portable power module functions on public roads providing at least one mega-watt in a normal operating configuration (emphasis added). Respectfully, it is extremely obvious that the devices (motor, generator, radiator, etc), as disclosed in the claims, function in normal operating configuration “within” or inside the container. Thus the Double Patenting Rejection is maintained.
- With respect to the Double Patenting Rejection under Campion (US 2003/0029390), again, the features are strongly disclosed in claims 1 and also in claim 7 (see claim 7, lines 1-3, 13-32; see also claims 22, 23).
- With respect to the Double Patenting Rejection under Campion (US 2003/0033994), the features of the claims are well disclosed in claims 16 and it is disclosed that the devices operate “in a normal operating configuration” within the interior of the container. See also claims 22.

- With respect to the USC 103 rejection, Bernard et al (US 6,450,133) teaches that it is well known in the art to have an electrical generator 44 being inside a container, a gas fuel motor 38, which diesel can be considered a gas, a radiator composed of elements 72, 74, 76, 78 (see figures 2, 3) and a silencer 45 all inside the portable power module trailer (see figure 1).

12. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the main reference, Bernard et al places a strong foundation for teaching the main concept disclose in the claims being rejected. The secondary references were used to show that certain modifications to power systems can be made base on desirable results.

***Conclusion***

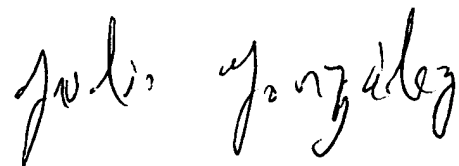
13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio C. Gonzalez whose telephone number is 571-272-2024. The examiner can normally be reached on M-F (8AM-5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 571-272-2044. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Julio C. Gonzalez". The signature is written in a cursive, flowing style.

Julio C. Gonzalez  
Examiner  
Art Unit 2834

Jcg

September 2, 2005